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Applicant : Scott C. Harris
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Scott Harris

Board of Patent Appeals and Interferences
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Applicants Brief On Appeal

Sir:

Applicant herewith files this Brief on Appeal thus perfecting the Notice of Appeal which was originally filed on January 31, 2005.

Please charge the Appeal Brief fee of \$160 for this filing to deposit account number 50-1387.

The present application qualifies for small entity status under 37 C.F.R. § 1.27.

The headings and subject matter required by rule 41.37 follow.

Real Party In Interest

The inventor, Scott C. Harris, is the real party in interest.

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Related Appeals and Interferences

There are no known related appeals and/or interferences.

Status of Claims

Claims 1-7, 14-16, and 21-24 are pending. Claims 8-13, 17-20 were previously canceled. Each of these claims are appealed herein.

Status of Amendments

No amendment was filed after the claimed final rejection.

Summary of Claimed Subject Matter

Claim 1 requires receiving an e-mail message, which is described in the specification page 3 in the first paragraph. Claim 1 further defines displaying information about the message in a way that allows deleting the message in one of three different ways: without detecting whether it is spam or not; while indicating that it is spam, or while indicating that it is not Spain. This is shown in Figure 1 respectively by the three buttons 107, 111, and 112.

Claim 14 requires a display that displays a number of e-mails, shown generally at Figure 1, item 110. Claim 14 also requires a first control that selects deleting the e-mail while indicating that it is spam, and a second control selecting deleting the e-mail while indicating that it is not spam. The controls 111 and 112 in Figure 1 provide support for this.

Claim 21 recites determining a plurality of characteristics of an unwanted message, described in the specification for example, page 6 line 8 and page 7, next-to-

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last paragraph. A list with a plurality of characteristics is formed, see generally element 410 in Figure 4, and the database described on page 6. A numerical score for an incoming message is created by comparing that incoming message with the list. See generally the first paragraph on page 8 referring to element 410 in Figure 4. Messages are defined as being unwanted based on a numerical score, see the bottom of page 9 of the specification. The e-mail is an appropriately processed, see the top of page 10.

Claim 23 cites a method of obtaining an e-mail message, see generally page 3. The user interface, shown as 102 in Figure 1 allows deleting the message in one of three different ways, see the buttons 107, 111 and 112 in Figure 1.

Grounds of Rejection to be Reviewed on Appeal

Is Claim 1 properly rejected as being anticipated by Paul.

Are claims 14, 16 and 20 3-24 properly rejected as being anticipated by Nielsen.

Are claims 2-7 and 21-22 properly rejected as being unpatentable over Paul in view of McCormick.

Is claim 15 properly rejected over Nielsen in view of Leeds.

ArgumentClaim 1

Claim 1 is rejected under 35 U.S.C. 102 was allegedly being unpatentable over Paul. This contention is respectfully traversed, and for reasons set forth herein, it is respectfully suggested that the rejection does not meet the Patent Office's burden of providing a prima facie showing of unpatentability.

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Claim 1 requires receiving an e-mail message, and displaying information about the message in a way that allows deleting the message without indicating whether it is spam or not, deleting the message while indicating that it is spam, or deleting the message while indicating that it is not spam. That is, claim 1 requires these three different options for displaying information about deleting the message. Paul, however, does not teach or suggest these three different options. Admittedly, Paul discloses a heuristic filtering system (see generally column 4 lines 13-28) that attempts to classify whether the message represents spam. The e-mail is displayed along with a suggested display code that was created from the heuristic filters. Therefore, the email is displayed along with the system's recommendation about whether the email represents junk.

The marking as junk is done by Paul based on the contents of the heuristic filters. For example, see Figure 4 which shows performing heuristic processing, and based on that heuristic processing, at 420, mark the e-mail as junk. The same thing is shown in Figures 4A, and Figure 6. There is also an inclusion list filtering in Figure 6.

The user can modify the "inclusion list", which sets more data about which e-mails are marked as junk. See generally column 5 lines 33-37. Note however that the filter is what accesses, modifies and characterizes the e-mail messages; see generally the specification column 6 lines 48-50 and 55. The embodiment of Figure 3, similarly performs filtering to determine if the e-mail is junk. See column 7 lines 36-40. Figures 4, 4A and the others are all similar. It is, unlike the present system that displays information "in the way that allows at least one of deleting the message without indicating whether it is spam or not, deleting the message while indicating that it is

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spam, or deleting the message while indicating that it is not spam", Paul teaches annotating the message with a portion indicating whether it is likely spam. Displaying whether a message is spam is entirely different than allowing deleting the message in one of these three ways noted above.

Referring to the portions noted in the specification, the rejection alleges that the three forms of deleting include certain display codes. None of these codes indicate that the message is to be deleted in certain ways as claimed. Moreover, with all due respect, a display code does not disclose a way of deleting an e-mail.

The rejection refers to clauses in claim 1. These clauses refer to the way that the e-mail is marked with a display code for display to the user. For example, if the message is of interest to the user, it is marked with a second display code and displayed in a second display format. The way that the messages are displayed says nothing about "deleting the message" as claimed.

In the response to argument, the rejection states that it is submitted that e-mail deleting functionality is inherent in all e-mail systems...". However, this is entirely beside the point. Paul classifies e-mails into different categories of junk or not junk. According to the rejection, when the end-users delete the e-mail using the conventional delete button, they are removing it and moving it to the e-mail filter. Somehow, this is alleged to be the same as what is being claimed by claim 1. This is quite incorrect. In fact, this line of reasoning would lead to the conclusion that there is only one delete function in Paul, the "conventional" delete function.

Quite simply, this reads functionality into Paul which was never even wildly contemplated by Paul and is certainly not disclosed thereby. Paul discloses nothing

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about deleting e-mails. Even if it is true that all e-mail systems must have a delete function (something which was never really contemplated by Paul) it certainly does not disclose the specific claimed subject matter which requires displaying information in a way that allows 1) deleting the message without indicating whether it is spam or not, 2) "deleting the message while indicating that it is spam" or 3) "deleting the message while indicating that it is not spam". Nothing in Paul discloses anything other than displaying probable spam indications. The rejection is trying to read 1-3 above into a system that, by the rejection's own admission, never even CONTEMPLATED deleting. Paul discloses nothing about displaying instructions which would enable deleting messages in this way. All of the limitations of claim 1 are clearly not found in Paul, therefore, and therefore claim 1 should be allowable thereover.

Claims 14, 16 and 23-24

These claims are all rejected as allegedly being anticipated by Nielsen. Nielsen teaches a system which allows a function to "delete as junk mail". There is also a function to just delete the message, without indicating whether it is junk mail or not. See Figure 4b which has two options: "delete as junk mail"(425) and "delete message" (427).

Note that this recites and shows only two different ways of deleting the email, either deleting it as junk mail (425) or just deleting it (427). When the recipient deletes as junk mail, the Figure 10 process is invoked, see generally column 11 lines 49-51, to learn from the junk mail. When the user just plain deletes, no process is invoked.

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Nothing is learned from the "delete message". The user simply has not indicated whether the e-mail is junk mail or not.

Claim 14 allows the system to learn from either known junk mails or known non-junk mails. Nielsen has no disclosure of such.

This means, therefore, that Nielsen either 1) deletes as junk mail, or 2) deletes, but does not indicate whether it is junk mail or not. Claim 14, on the other hand, allows two controls, one of which indicates that it is junk mail (like 425 in Nielsen) and the other of which deletes the e-mail while "indicating that said e-mail is not spam". This allows learning characteristics of e-mails which are NOT spam. Nowhere does Nielsen meet this latter function. As extensively described above, 427 just deletes the message, it does not indicate that the message is not spam; it simply does not indicate either way.

In item 38 of the rejection, the rejection attempts to make an intended use argument. The rejection states that if the prior art structure is capable of performing the intended use, then it meets the claim. This broad statement, out of context, means nothing. If this statement were true, then no software patent could ever be issued, because the first computer patent would be capable of carrying out any intended use that could later be claimed. Moreover, Nielsen provides no indication that it is even capable of performing the intended use. The rejection is reading much more into Nielsen than is actually disclosed.

Item 38 then goes on to state that "the examiner is having a difficult time understanding the functionality differences between "delete an e-mail while indicating that said e-mail is not spam" in the claimed invention, and the delete control of Nielsen allowing the users to delete their e-mails as not spam in Nielsen's teachings". Quite

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simply, this reads more into Nielsen than is really disclosed. Nielsen's delete message button does not indicate that the message is not spam, it simply indicates that the user has not decided whether the message is spam or not. Nielsen never teaches a delete as not junk mail button. He only teaches a 'delete without deciding' button.

Claim 16

Claim 16 further adds a third control that allows deleting without indicating, or not indicating, whether the e-mail represents "spam". That is, claim 16 defines three different options 1) to delete as spam, 2) delete as not spam or 3) delete without indicating whether or not it is spam. Figure 4b of Nielsen shows two different options, nothing in Nielsen discloses a third option. Clearly claim 16 is not anticipated by Nielsen.

Claim 23

Claim 23 requires a user interface that allows selection to any of:

- A) delete the message without indicating whether or not it represents spam,
- B) delete the message while indicating that it does indicate spam,
- C) delete the message while indicating that it does not indicate spam.

Nielsen does not disclose this. Nielsen only discloses the two options to delete as junk mail (425) and delete message (427) without indicating whether it is junk mail or not.

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Rejections Under Section 103

Claims 2-7 and 21-22.

Claims 2-7 and 21-22 are rejected based on Paul in view of McCormick. Claims 2-7 depend from claim 1 and should be allowable by virtue of their dependency on claim 1. Nothing in McCormick teaches or suggests displaying information which enables deleting the e-mail message in at least one of three different ways as claimed.

Claim 7

Claims 7 requires that the "fields", specifically the fields which are analyzed to determine whether the message is spam, include links within the e-mail message. Analyzing links is nowhere taught or suggested by Paul in view of McCormick and should be independently allowable.

Claim 21

Claim 21 defines forming a numerical score of the incoming message by comparing the incoming message with a list, determining commonalities, and defining the message as being likely unwanted if the numerical score is within a predetermined range.

Paul teaches filtering messages based on an inclusion list and characteristic criteria, see the top of column 9. The inclusion/exclusion list is described beginning at column 3 line 54. It determines whether categories are found or not. There is no teaching or suggestion of a numerical score in Paul. The rejection alleges that McCormick teaches a numerical score, referring to column 8 lines 48-65. This portion,

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however, simply refers to a number of users submitting the same e-mail to a collaborative filter. When the multiple users send that same e-mail, then the collaborative filter decides that the e-mail is spam and starts filtering it. It does not require source filtering of e-mail header addresses and the like. Rather, it just filters the messages based on the number of times users have indicated that the specific message is spam. Nowhere is there any teaching or suggestion of a numerical score, as claimed.

Note that claim 21 requires forming a numerical score by comparing the incoming message with the list and determining commonalities between the incoming message and the list. McCormick does not teach or suggest a numerical score of this type. Nowhere is there any teaching or suggestion in McCormick of a numerical score, formed from comparing the message with the list, as claimed.

Claim 22

The rejection alleges that Paul assesses the commonness of the domain of the sender, referring to column 11 lines 21-23 and column 12 lines 54-61. The cite to column 11 refers to subclause C of claim 10 which simply states that the domain matches a domain on the list: presumably the safe list. This has nothing to do with how common the domain is, and does not render obvious claim 22. Column 12 line 54 refers to subclause A of claim 27; which is again a user inclusion list and has nothing to do with whether the domain is common or not. Therefore, claim 22 should be further allowable over the cited prior art.

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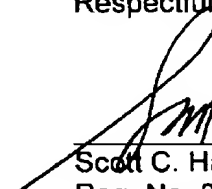
Claim 15 was rejected over Nielsen in view of Leeds. Claim 15 requires a weighted scale. However, claim 15 should be allowable by virtue of its dependency.

In summary of the above, the Patent Office has failed to meet their burden of providing a prima facie showing of unpatentability. For all of these reasons, it is respectfully suggested that all of the claims should be in condition for allowance and that the Examiner's rejection should be reversed.

Please charge any fees due in connection with this response to Deposit Account No. 50-1387.

Respectfully submitted,

Date: 3/31/05



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Attachment: All Claims on Appeal

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APPENDIX - ALL CLAIMS ON APPEAL

1. A method, comprising:

receiving an electronic mail message;

displaying information about the electronic mail message in a way that allows at least one of deleting the message without indicating whether it is spam or not, deleting the message while indicating that it is spam, or deleting the message while indicating that it is not spam.
2. A method as in claim 1 further comprising storing a database of spam likelihood, and wherein said deleting while indicating updates information in the database.
3. A method as in claim 1 wherein said deleting while indicating updates rules in a rules database.
4. A method as in claim 3 wherein said rules include information about fields from said electronic mail message.
5. A method as in claim 3 wherein said fields include at least a sender of the e-mail message, text of the e-mail message, and a subject of the e-mail message.

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6. A method as in claim 5 wherein said fields also include a domain of a sender of the e-mail message.
7. A method as in claim 3, wherein said fields include links within the e-mail message.
14. An e-mail program, comprising:
 - a display portion which displays a plurality of e-mails;
 - a plurality of controls including at least a first control which selects deleting an e-mail while indicating that said e-mail is spam, and a second control which selects deleting an e-mail while indicating that said e-mail is not spam.
15. A program as in claim 14, further comprising displaying a likelihood of spam coefficient which indicates, on a weighted scale, a likelihood that the associated message represents spam.
16. A program as in claim 14, further comprising displaying a control which allows deleting an e-mail without indicating or not indicating whether said e-mail represents spam.
21. A method, comprising:
 - determining a plurality of characteristics of an unwanted message;
 - forming a list with said plurality of characteristics;

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forming a numerical score of an incoming message by comparing said incoming message with said list and determining commonalities between said incoming message and said list;

defining said message as likely being unwanted if said numerical score is within a predetermined range; and

taking an action to restrict said message based on said defining.

22. A method as in claim 21, further comprising assessing a common-ness of a domain a sender of a message, and using said common-ness of said domain.

23. A method, comprising:

obtaining an electronic mail message; and

a user interface that displays information about said electronic mail message, and which user interface allows a selection to any of:

A) delete the message without indicating whether or not the message represents spam,

B) delete the message while indicating that the message does indicate spam, or

C) delete the message while indicating that the message does not indicate spam.

24. A method as in claim 23, further comprising a database of information indicating likelihood of spam, and wherein said delete while indicating that the message does indicate spam updates information in said database.